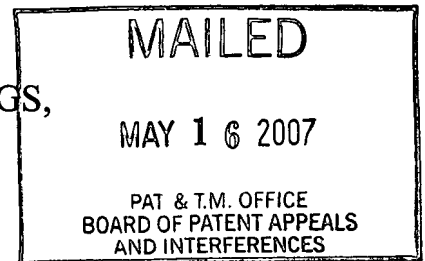


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAVADA CAMPBELL BOGGS,
HANNONG RHIM
LESLIE DOBBINS
AND S. SCOTT FRIDERICH



Application No. 09/855,180

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on April 2, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

An Information Disclosure Statement (IDS) was filed on May 13, 2004. A review of the Image File Wrapper reveals that the examiner has not considered the IDS. According to MPEP § 609 which states:

“ The Examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08A and 08B form.”

On July 25, 2005, appellants filed an Appeal Brief under 37 CFR § 41.37. A review of the file reveals that the “Summary of Claimed Subject Matter,” as required by 41.37(c)(1)(v), is not properly set forth. 37 CFR § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The independent claims must be mapped to the disclosure, including specification page and line number, and, if applicable, drawing reference characters.

Correction is required. MPEP § 1205.03 states:

When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter

as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

Further review of the file reveals that "Evidence appendix" and "Related proceedings appendix" are missing from the Appeal Brief according to

41.37(c)(1)(ix) and (c)(1)(x) which states:

(ix) ***Evidence appendix***. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) ***Related proceedings appendix***. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Appropriate correction is required.

On September 29, 2005, an Examiner's Answer was entered into the record. In the Evidence Relied Upon section, page 2, paragraph 8, the examiner has stated, "No evidence is relied upon by the examiner in the rejection of the claims under appeal." A review of the file reveals that references to Kimberly Clark '550, and 3m '264 were applied to the statement of rejections in the Grounds of Rejection, paragraph (9) of the examiner's answer.

Before further review, the examiner must mail a PTOL-90 that will include in the Evidence Relied Upon section, the list of references mentioned in the statement of rejections. See the Manual of Patent Examining Procedure, (MPEP) 1207.02.

Appropriate correction is required.


In addition, the references to Kimberly Clark '550 and 3M '264 are missing from the electronic file. Appropriate correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner

- 1) for consideration of the IDS filed May 13, 2004;
- 2) hold the Appeal Brief on July 25, 2005, defective;
- 3) notify appellants to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 4) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) ;
- 5) issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer;
- 6) have a complete copy of the references to Kimberly Clark EP'550 and 3M'264 scanned into the record; and
- 7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
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PJN/dal

Application No. 09/855,180

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